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BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS

In re Application of: Gerald Owen, et al.	Date:	April 29, 2005
Serial No.: 10/689,750	Group Art Unit:	3644
Filed: 10/22/2003	Examiner:	Behrend, Harvey
Title: CUSTOMIZED LURE SYSTEM		

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450.

Terry Lakos — 4/29/05

Name: Terry Lakos — Date

Reply to Examiner's Answer

Hon. Commissioner of Patents and Trademarks
Alexandria, VA 22313-1450

Dear Sir:

This is a reply to the Answer mailed on April 26, 2005.

In appears, as previously described, that the present invention includes a number of features that are unanticipated in the above mentioned references. The present invention allow the fisherman to quickly customize his or her lure to the fishing conditions encountered, and to reconfigure the lure in a modular manner without the need to purchase or carry many different configured lures and hooks.

The examiner cites St. Regis Paper Co. v. Bemis Co., (cited as 13 USPQ 8, but assumed to be 193 USPQ 8), to support his conclusion that duplication of working parts

involves only ordinary skill, and that the module design of the present invention is merely a replacement or duplication of the working parts of Tallerico, even though admitting that Tallerico does NOT disclose a plurality of lure module elements. However, the conclusion of St. Regis Paper Co. v. Bemis Co. that a "combination patent is not valid unless the combination of elements achieves a synergistic effect" was reversed by Republic Industries, Inc. v. Schlage Lock Co., 592 F.2d 963, 967-972 (7th Cir. 1979), a decision later upheld in Deere & Co. v. International Harvester Co., 496 F.Supp. 397 at 400 (U.S. Dist. 1980).

Consequently, the reliance upon the dicta that a combination requires greater inventive flair than that of a person skilled in the art would provide is the incorrect standard for determining whether the present invention, with its placement of a plurality of interchangeable modules and elements to allow the fisherman to quickly customize his or her lure to the fishing conditions encountered is an obvious extension of Tallerico, which neither discloses nor anticipates any of these functions, is incorrect.

When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. In re Ichihashi, Civ. App. No. 93-1172, slip op. at 2-3 (Fed. Cir. Sep. 9, 1993) (unpublished)

In the absence of some evidence of the level of ordinary skill, including evidence tending to show what one of such ordinary skill would be motivated to accomplish in view of the cited prior art, the board may not rest a prima facie case only on its own unsupported assertions. Swede Industries v. Zebco Corp., Civ. App. No. 93-1403, slip op. at 4-5 (Fed. Cir. April 12, 1994) (unpublished)

It is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. Additionally, there is no indication as to the motivation for combining those known element that may appear in the present invention. Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,

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